

REMARKS

Claims 3-7, 10, 13, 14 and 16-18, 20 and 23-27 are now in the application. Claims 3-5, 10, 13-14 and 20 and 23-25 are directed to the elected invention. Claims 6, 7 and 16-18 are drawn to non-elected invention and may be canceled by the Examiner upon the allowance of the claims directed to the elected invention. Claim 23 has been amended to recite that the "water-soluble resin is a polyallylamine which is a homopolymer having a constituent unit expressed by the chemical formula (2)" to clarify that the polyallylamine is a homopolyallylamine to address comments made in the Advisory Action. The amendments to the claims do not introduce any new matter.

With respect to the Information Disclosure Statement filed June 20, 2008, it is respectfully requested that the Examiner consider and acknowledge that Information Disclosure Statement. For the Examiner's convenience, attached are the form PTO/SB/08 A/B and one copy each of the Citation and English language Abstract filed June 20, 2008 and English translation of the Office Action in counterpart Chinese application 200310113016.5. Please note that in that Information Disclosure Statement that pursuant to 37 CFR 1.97(e)(1), each item of information contained in the Information Disclosure Statement filed on June 20, 2008 was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement on June 20, 2008. In particular, as previously mentioned, Citation BA was cited in an Office Action issued on March 21, 2008 in a counterpart Chinese application.

Claims 23-27 were rejected under 35 U.S.C. 102(a) as being anticipated by JP 2002-275642 (JP'642). Claims 3-5, 10, 13-14 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP'642. JP 2002-275642 does not anticipate and does not render obvious the present claims. As a preliminary matter, it is noted that the body of the Final Office Action also referred to claims 1 and 2 which have been cancelled and therefore are not subject to these rejections.

JP 2002-275642 does not anticipate and does not render obvious the present claims since, among other things, JP'642 does not disclose a homopolymer of allylamine. In particular, it was stated in the Advisory Action, that the claimed polyallylamine reads on copolymers since the claim does not state that it is a homopolymer. As discussed above, Claim 23 has been amended to recite that the "water-soluble resin consists only of a constituent unit expressed by the chemical formula (2)" to clarify that the polyallylamine is a homopolyallylamine to address these comments made in the Advisory Action. In view of the amendment to claim 23, one cannot reasonably interpret the claimed polyallylamine to read on a copolymer.

In addition, it was asserted in the Final Office Action that polyallylamine is substantially disclosed in the cited reference. The following description was relied upon: "homopolymer or copolymer of monomers having...amino...groups..." and the description of allylamine as the monomer. However, this description must be read in conjunction with the entire paragraph [0065] from which it was taken as well as the entire disclosure. As clearly stated in paragraph [0065], the polymers referred to acrylic resins which can be either homopolymers or copolymers. Specifically, the description "homopolymer" of the cited reference, paragraph [0065] relates to monomers having an acrylic acid skeleton such as N,N-dimethylaminoethyl(meth)acrylate.

These homopolymers do not include and do not contemplate a homopolymer of allylamine. Thus, the homopolymer of monomers does not include a homopolymer of allylamine. Thus, allylamine is not used as monomer of a homopolymer, but as a possible monomer of a copolymer.

As discussed above, a homopolyallylamine is not used in JP 2002-275642, but allylamine is merely suggested in an acrylic resin as one possible comonomer therein. In the invention in the present application, the purpose of polyallylamine being used, is that an effect of an amino group of polyallylamine is exhibited by polyallylamine incorporated into a chemical conversion coating film. The presence of the amino groups improves the adhesiveness of an upper coating film. The present invention provides for effective and advantageous adhesive effects since the polyallylamine consists only of the unit represented by Chemical Formula (2) and therefore has a large number of amino groups. The high adhesive effect achievable by the present invention would not be achieved using a resin suggested in JP 2002-275642, which, at most, would have a

fewer number of amino groups compared to a polyallylamine that consists only of the unit represented by Chemical Formula (2) as recited in the present claims.

JP 2002-275642 fails to anticipate the present invention since anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. *See Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir.1986).

Each and every claim recitation must be considered. *See Pac-Tec, Inc. v. Amerace Corp.* 14 USPQ2d 1871 (Fed. Cir. 1990), cert. denied 502 US 808 (1991).

Therefore the present invention is not anticipated by JP 2002-275642 and is not obvious there over.

In view of the above, reconsideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

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The Office is authorized to charge any necessary fees due with this response to Deposit Account No. 22-0185 under Order No. 27617-00002 US from which the undersigned is authorized to draw.

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Respectfully submitted,

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